

## **REMARKS**

Claims 42-83 are now pending, with claims 42-67 having been previously withdrawn. Claims 42, 62, 68, and 77 are independent.

In the Office Action, Claims 68-83 received a nonstatutory double patenting rejection. Claims 68 and 77 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and those claims were also rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 68-83 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,533,097 (*Crane*).

### **The Double Patenting Rejection**

Applicants respectfully traverse the double patenting rejection of claims 68-83 over claims 1, 24, 25, 55, 65, 69, and 73 of patent 6,427,078. The claims of the issued '078 patent and the claims of this pending application are directed to different inventions, which are not obvious over each other. First, all of the claims in the '078 patent include either a "camera unit," a "camera card," or a "camera" as a claim limitation, while none of claim in this patent application requires such a limitation. And second, none of the claims in the '078 patent includes language that corresponds to enabling "a user to select a destination for a wireless transmission of an image from a list of potential destinations," which appears in claim 68. Applicants therefore submit that claim 68 is directed to an invention that is not the same as, and is not obvious over, the claims of the '078 patent. Claim 77 includes similar language and is therefore also not the same as, and not obvious over, the claims of the '078 patent. Applicants therefore respectfully request withdrawal of the double patenting rejection.

### **The Rejections under 35 U.S.C. § 112**

Applicants respectfully traverse the rejections under 35 U.S.C. § 112, first and second paragraphs. The paragraph that spans pages 12 and 13 of the originally filed specification (i.e., ¶ 46 in US 2002/0082043, which is the published version of this application) reads as follows:

The notebook computer according to the invention comprises a number of facilities and/or application programs, by means of which the possibilities of the notebook computer can be utilised effectively. Such tools include, for instance: electronic calendar, phone list and note pad, fully integrated with each other and to the communications, data collection and data processing functions of the notebook computer. The services used most frequently include functions related to speech communications, telefax function, electronic mail, paging, data bank services and on-line information service connections. When transmitting electronic mail or telefax messages, the user can digitise the message on the display of the notebook computer and to simply select the recipient information from the phone list. The phone list is generally an application which offers an easy way to select the address information of the recipient for a chosen electronic contact as well as for a possible written letter. The user can input address information and telephone number information of different people in the memory of the notebook computer by means of the camera unit functioning as the data collection device and by means of suitable utility functions related to the camera unit. The address file may include different additional information, such as a telephone number, telefax number, email address as well as other necessary information, in addition to the name and address. (*Emphasis added.*)

The paragraph reproduced above and other portions of the specification (including but not limited to paragraphs 29, 34, 35, and 45 of US 2002/0082043) show that Applicants described, enabled, and possessed the invention that can wirelessly transmit image data to a remote location and also wirelessly transmit speech and text. The portions underlined above also show that the system included a routine that enables a user to select a destination for a wireless transmission of an image from a list of potential destinations. The last two sentences quoted above also provide additional details for implementing a suitable phone list and address file.

Applicants respectfully submit that these portions of the specification satisfy the first and second paragraphs of 35 U.S.C. § 112, and respectfully request withdrawal of the § 112 rejections.

### **The Rejections under 35 U.S.C. § 102**

Applicants respectfully traverse the rejections under 35 U.S.C. § 102. The last paragraph of claim 68 recites that “the application software includes a routine that enables a user to select a destination for a wireless transmission of an image from a list of potential destinations.” The undersigned has reviewed the entire disclosure of *Crane*, and did not find this limitation in the portions of *Crane* that were cited in the Office Action, or anywhere else in *Crane*. As understood by the undersigned, col. 5, lines 53-62 is the only part of *Crane* that discusses making selections from a phone list. But that portion of *Crane* relates to selecting a destination for “a cellular phone call” from a phone list. See *Crane* at col. 5, lines 53-54 and 60-61. The undersigned was unable to locate any portion of *Crane* that relates to selecting a destination for an image transmission from such a list. Accordingly, Applicants respectfully request withdrawal of the § 102 rejection of claim 68. In the alternative, if the rejection is not withdrawn, Applicants respectfully ask the examiner which portions of *Crane* disclose “select[ing] a destination for a wireless transmission of an image from a list of potential destinations.”

Claim 77 contains similar limitations, and is therefore believed patentable for the same reasons as claim 68.

The other claims in this application each depend on one of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Application No. 10/085,883  
Reply dated January 31, 2011  
(in response to the Office Action dated October 29, 2010)

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at (212) 969-3246. Please continue to direct all correspondence to Customer No. 42532 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP

Date: January 31, 2011

By: /Robert S. Mayer/  
Robert S. Mayer  
Registration No. 38,544  
Attorney for Applicants

Proskauer Rose LLP  
Patent Department  
One International Place  
Boston, MA 02110-2600  
Tel. (212) 969-3246 (direct)  
Fax (617) 526-9899